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10/070,601	02/28/2002	Akihiro Kuroda	3094-39	7638
29540	7590	05/17/2006	EXAMINER	
PITNEY HARDIN LLP 7 TIMES SQUARE NEW YORK, NY 10036-7311			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/070,601

Applicant(s)

KURODA ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on March 3, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-21, 23, 25, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-21, 23, 25, 29, and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date, _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on March 3, 2006. Claims 1, 3-21, 23, 25, 29, and 30 are pending. Claim rejections made under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated November 30, 2005, are maintained for the reasons of record.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**1. Claims 1, 3- 9, 12, 15, 19-21, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 5061481) in view of Sakuta (US 4970252)**

Suzuki teaches a composition comprising of methylphenylpolysiloxane (nonvolatile low viscosity silicone oils, of instant claims 3, 6, and 7) and dimethylpolysiloxane, both having viscosity of 10 cs; acryl-silicone graft copolymer and partially cross-linked organopolysiloxane polymer (instant claims 8 and 12). See Example 11. The weight amount of dimethylpolysiloxane is 10 wt %. See instant claim 29. Example 12 also contains a titanium dioxide in Example 12. See instant claim 20. The reference also teaches that the invention is a composition comprising volatile silicone oils such as octamethylcyclotetrasiloxane and decamethylcyclopentasiloxane. See col. 11, lines 3 – 8; instant claims 3-5. The reference teaches that any silicone oils having a viscosity below 50 cs can be used as the low viscosity silicone oil. See col. 5, lines 31 – 43. The reference further teaches that perfluoroalkyl(methyl)acrylates

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can be also used to form the acryl-silicone graft copolymer of instant claims.

See, col. 3, line 58 – col. 4, line 17. See instant claim 19. The reference teaches eyeliner composition comprising 1,3-butylene glycol, which has hydroxyl groups.

See instant claim 30.

While the reference teaches that any liquid silicone oil can be used and teaches octa- and deca-methylcyclcopentasiloxanes, dimethylpolysiloxane, and methylphenylpolysiloxane, the reference fails to particularly mention the organopolysiloxane of formula (I) of instant claim 1, (methlytris(trimethylsiloxy)silane). See col. 5, lines 31 – 42. The reference teaches that 2 or more of low viscosity silicone oils can be used in combination if necessary. See col. 6, lines 44 – 48.

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is comparable substitute for other low viscosity silicone oil also well known in the art. Methlytris(trimethylsiloxy)silane is said to have 1 mm<sup>2</sup> /s (cSt). See col. 4, lines 16 – 35. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Suzuki by adding methlytris(trimethylsiloxy)silane with, or methlytris(trimethylsiloxy)silane for the low viscosity silicone oils that are taught in the reference, as motivated by

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Sakuta. The evidence for the motivation to modify the prior arts is found in Sakuta, as the reference teaches that methlytris(trimethylsiloxy)silane is a functional equivalent of the volatile silicone oils of Suzuki, such as octamethylcyclotetrasiloxane or decamethylcyclopentasiloxane. The skilled artisan would have had a reasonable expectation of successfully producing a similar cosmetic composition because Suzuki teaches that any silicone oils having a viscosity below 50 cs, either individually or in mixture, can be used.

Alternatively, it is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of two conventional low viscosity silicone oils well known in cosmetic art. It would follow that the recited claims define prima facie obvious subject matter.

The references do not teach the resulting low-temperature stability property of the combined composition as recited by applicants in claim 1. However, it is well settled in patent law that, to make a prima facie case of obviousness, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). In this

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rejection, although the reason to combine Suzuki and Sakura is not to achieve a composition with low temperature stability, the references provide a skilled artisan a motivation to make the claimed composition as discussed above.

**2. Claims 1, 8, 9, 12, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Mellul (US 5496544) in view of Sakuta (US 4970252).**

Mellul teaches cosmetic composition comprising a silicone gum, a silicone wax, and a silicone resin, and low-viscosity silicone oil. See col. 3, line 1 – col. 5, line 21; Example 4. The reference teaches using silicone polysiloxane gums having MW of 200K-1000K, and particularly mentions polymethylsiloxanes. See col. 3, lines 31 – 49. See instant claims 8 and 9. Example 4 also contains mica and talc. The reference in col. 5, lines 55 – 58 also teaches iron oxides, which are well known UV screening agents. See instant claims 20, 21. The reference also teaches trimethylsiloxysilicate in the compositions. See Examples; instant claims 8 and 12.

Mellul fails to teach the silicone oil of instant claim 1, formula (I).

Sakuta ('252), as discussed above, teaches methlytris(trimethylsiloxy)silane, the silicone oil of instant claim 1, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Mellul by substituting the low viscosity silicone oil with methlytris(trimethylsiloxy)silane as

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motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

The references do not teach the resulting low-temperature stability property of the combined composition as recited by applicants in claim 1. However, it is well settled in patent law that, to make a prima facie case of obviousness, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). In this rejection, although the reason to combine Mellul and Sakura is not to achieve a composition with low temperature stability, the references provide a skilled artisan a motivation to make the claimed composition.

**3. Claims 1, 8, 10, 11, 13, 14, 20, 21, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Nakamura et al. (US 5853711) in view of Sakuta (US 4970252).**

Nakamura teaches a water-in-oil emulsion cosmetic composition comprising a mixture of organopolysiloxane elastomer spherical powder and a hydrophobic silica powder; and an oil phase containing at least 30 % by weight, based upon the total oil phase, of silicone oil. See abstract; Examples. See instant claims 8 and 10. Dimethylsilylated silica powders, AEROSIL R972 (polyalkylsilsesquioxane), and trimethylsilylated silica powders, AEROSIL R813, are disclosed in col. 3, lines 12 – 21. See instant claims 11 and 13. The reference also teaches silicone oils including methylpolysiloxane,

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methylphenylpolysiloxane, cyclic dimethylpolysiloxane

(octamethylcyclotetrasiloxane, etc) in the oily phase. See col. 3, lines 33-48. The reference also teaches using glycerol (which has 3 hydroxyl groups) and thickeners. See col. 6, lines 12 – 14. See instant claim 30. The reference also teaches using polyether silicone surfactant. See col. 4, lines 13 – 26; claims 13 and 14.

Nakamura fails to teach methlytris(trimethylsiloxy)silane of claim 1, formula (I).

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is compatible substitute for other low viscosity silicone oil also well known in the art.

Methlytris(trimethylsiloxy)silane is said to have 1 mm<sup>2</sup>/s (cSt). See col. 4, lines 16 – 35. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Nakamura by substituting the disclosed silicone oils with methlytris (trimethylsiloxy)silane as motivated by Sakuta ('252) because the latter teaches the functional equivalency of the organopolysiloxane with the silicone oils that Nakamura teaches. The skilled artisan would have had a reasonable expectation of successfully producing a similar cosmetic composition.



The references do not teach the resulting low-temperature stability property of the combined composition as recited by applicants in claim 1. However, it is well settled in patent law that, to make a prima facie case of obviousness, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). In this rejection, although the reason to combine Nakamura and Sakura is not to achieve a composition with low temperature stability, the references provide a skilled artisan a motivation to make the claimed composition by combining the teachings of the references.

**4. Claims 1, 15-18, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over in view of Sakuta (US 5236986) ('986) in view of Sakuta (US 4970252) ('252).**

Sakuta ('986) teaches a cosmetic composition comprising a mixture of a crosslinked silicon polymer and a low viscosity silicone oil, the mixture being kneaded under shearing conditions sufficient to cause the silicone polymer to be swollen with the silicone oil. See col. 2, lines 61 – 66. See instant claim 18. The silicone oil preferably has a viscosity at 25 °C of not higher than 100 centistokes, and the Examples use dimethylpolysiloxane. The reference teaches that the polymers are obtained by addition polymerization of at least one organohydrogenpolysiloxanes and either polyoxyalkylene or organopolysiloxane disclosed in col. 2, lines 25 – 31, and col. 3, lines 42 – 68. Example 1 teaches

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that organopolysiloxane having at least two alkenyl groups per molecule is reacted with the product in Synthetic Example 1, which contains Si-H bond. See instant claim 16. Application example 1 contains 1,3-bis(2-hydroxyethyl) glycol, which has two hydroxyl groups. See instant claim 30.

The reference fails to teach the compound of instant claim 1, formula (I). Sakuta ('252) teaches that methytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is a compatible substitute for and a functional equivalent of other low viscosity silicone oil also well known in the art. Methytris(trimethylsiloxy)silane is said to have 1 mm<sup>2</sup>/s (cSt). See col. 4, lines 16 – 35. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of '986 by substituting the low viscosity silicone oil with methytris (trimethylsiloxy) silane as motivated by '252 because of the expectation of successfully producing a similar cosmetic composition.

The references do not teach the resulting low-temperature stability property of the combined composition as recited by applicants in claim 1. However, it is well settled in patent law that, to make a prima facie case of obviousness, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See In re Linter,

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458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). In this rejection, although the reason to combine '986 and '252 is not to achieve a composition with low temperature stability, the references provide a skilled artisan a motivation to make the claimed composition by combining the teachings of the references.

**5. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over in view of Suzuki, Sakuta as applied to claims 1, 3- 9, 12, 15,19-21, 28, and 30 as above, and further in view of Starch (US 6121383).**

Suzuki teaches that basic purpose of cosmetic composition is to impart moisturizing properties and that humectants are used for this reason. See col. 1, lines 22 – 29. The reference at col. 16, lines 56 – 68 also teaches to add humectant to the invention. The application of the invention includes solid foundation, liquid foundation, O/W emulsion, stick eyeshadow, and cream. See Examples.

Suzuki and Sakuta fail to teach the non-elastomer solid polysiloxanes of instant claim 25.

Starch teaches a method of thicken water-in-silicone emulsion which is useful in formulating cosmetics, including liquid foundations, antiperspirants, and skin moisturizers. See col. 1, lines 21 – 28. The reference teaches to add the latex in water phase rather than in silicone phase to delay swelling until the contact of the two phases to facilitate processing. See col. 1, lines 34 – 42. The reference teaches using cyclic siloxanes such as octamethylcyclotetrasiloxane,

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decamethylcyclopentasiloxane for the silicone phase. The reference teaches that trimethylsiloxysilicate, an MQ resin, is blended in film-forming organic polysiloxanes to make a silicone emollient. See col. 5, lines 10 – 38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the silicone emollient comprising trimethylsiloxysilicate as motivated Starch, because 1) all references are directed to cosmetic compositions; 2) Suzuki teaches using emollients; 3) and the skilled artisan would have had expected to successfully produce a cosmetic composition with emolliency.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-21, 23, and 25 have been considered but are unpersuasive.

Applicants assert that the present rejection fails to address "at least 5 wt % based on the total weight of said cosmetic of an organopolysiloxane expressed by following general formula (1). . . ." Examiner respectfully notes that the present limitation is rendered obvious because the primary references in the rejections teach the weight amount of low viscosity silicone oil which is functional equivalents of the organopolysiloxane, M3T. For example, as indicated in the body of rejection, Suzuki et al. teach using dimethylpolysiloxane in the weight amount of 10 wt %. Dimethylpolysiloxane is a low viscosity cosmetic silicone oil that thus is functional equivalent of M3T. It would have been obvious to a

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routinier based on the teachings of the references to use M3T in the amount in which Suzuki used the low viscosity silicones.

Applicants also assert the references do not suggest the properties of the composition which "does not exhibit phase separation after storage at 0 C". And then applicants go on to state, "applicants are also perplexed by the Examiner's comments regarding phrase "low-temperature stability" because this never was a claim limitation. The statements here contradict with each other because the low-temperature stability refers to the physical property of the composition which remains without phase separation after storage at 0 C, as applicants also have admitted in specification p. 40, bridging paragraph. The term "low-temperature stability" which has been recited in the previous claims, is not a preamble, but is a physical property which sets the structural limitation of the composition. The basis for addressing this limitation was that the rejection is still proper because skilled artisan could have had a motivation to combine the references that is independent from the motivation of the present application, and the composition made as suggested by the combined teachings of the references would obviously have this stability property.

Applicants also assert that In re Linter does not apply to the present case because the present rejection, according to applicants, does not address all the limitations of the claims. Examiner respectfully disagrees, for the reasons discussed above.

Applicants assert that the present invention demonstrates "superior properties". Examiner respectfully notes that the discovery of a new property

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(i.e., low temperature stability of M3T) does not amount to unexpected or nonobvious results that are require to overcome a prima face case of obviousness. See MPEP § 718.02 for the requirements of showing unexpected results.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 7:00AM until 4:30 PM..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**